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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,554	08/09/2007	Francois Moutel	1032326-000393	2258

21839 7590 12/26/2008
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

PHAN, THIEM D

ART UNIT	PAPER NUMBER
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3729

NOTIFICATION DATE	DELIVERY MODE
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12/26/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/577,554	Applicant(s) MOUTEL ET AL.	
	Examiner THIEM PHAN	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/28/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicants' election with traverse of Group I, Claims 1-9, filed on 11/03/08 is acknowledged. Applicants traverse the Restriction Requirement on the grounds that the Restriction for the inventions of Group I and Group II is not proper because both Group of claims, drawn to the method and the article claims, are of a single general inventive concept, and that the technical features of each of these Groups are interpreted by applicants to be the same (Remarks, page 1) because they are of well known features.

This is not found persuasive because the examiner has established a prima facie case having shown in the Restriction (filed 10/02/08), that the inventions of Groups I & II are **not so linked** under Rule 13.1 to form a single general inventive concept. Moreover, the special technical features of theses Groups I & II, defined under Rule 13.2 as those technical features that contribute to each of the inventions and considered as a whole, can't make over the prior art.

In accordance with MPEP Appendix AI, Section 206 and Annex B, under PCT Rule 13.1 and 13.2, the examiner has demonstrated that the inventions of Groups I & II are each independent or distinct as claimed (filed in 10/02/08)) and a serious burden would be placed on the examiner as discussed above.

Accordingly, Claims 10-14 are withdrawn from further consideration pursuant to 37 CFR .142(b) as being drawn to a nonelected Group, there being no allowable generic or linking claim.

The Restriction filed on 10/02/08 is hereby **made Final**.

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Applicants are required to cancel these nonelected claims (10-14) or take other appropriate action. An Office Action on the merits of Claims 1-9 now follows.

Title

2. The following title is suggested: "Method of manufacturing a USB electronic key".

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing in compliance with 37 CFR 1.121(d) is required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figure. If the changes are not accepted by the examiner, the applicants will be notified and informed of any required corrective action in the next Office action. The objection to the drawing will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, because the claims are written in such a fashion that they are not active verbs and therefore the metes and bounds of the claimed invention is difficult, if not impossible, to determine. For example, the claimed language "... is cut ..." (Claim 1, line 2), "... is adjusted at least ..." (Claim 1, line 5), "... is achieved by

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...” (Claims 2, 4 & 5, line 2), “... is interfitted with ...” (Claim 3, line 2), “... is fastened ...” (Claims 6 & 7, line 2) and “...is disposed ...” (Claims 8 & 9, line 2) are not in a form which clearly delineates the scope of the claims in U.S. Patent practice. Applicants would do well if they carefully review and rewrite each of the claims 1-9 with the view of using positive, active language in order to properly claim any patentable subject matter.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1- 3 and 5-9, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Yen (US 6,744,634) in view of Tetaka et al (US 6,159,770).

Regarding claim 1, Yen teaches a process of making low height USB interface with a microcircuit (Fig. 10, 202) defining USB-format contact pads (111) and carrying an electronic component (202A) connected to the pads, comprising the following step whereby, in a single operation, the thickness of the microcircuit is adjusted at least in the area (Fig. 8, 300A) of the contact pads, so as to have a thickness that conforms to the USB Standard (Col. 3, lines 56-60); which reads on applicants’ claimed invention, except for having the microcircuit cut out from a tape having a plurality of microcircuits.

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Tetaka et al teach a method of fabricating semiconductor devices with the microcircuit of semiconductor devices cut out from a tape (Fig. 54A, 133) having a plurality of microcircuits (133) in order to facilitate the handling and the automated assembling of theses microcircuits to a system (Col. 25, lines 20-24).

It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Yen by applying the microcircuits mounted on the tape, as taught by Yen, in order to facilitate the handling and the automated assembling of theses microcircuits to a system such as the USB Interface key.

Regarding claim 2, Yen teaches at least one bottom half-shell (Fig. 8, 113) disposed at least under the contact pads.

Regarding claim 3, Yen teaches that the bottom half-shell is interfitted with a top half-shell (Fig. 6, 112) covering a zone of the microcircuit that lies outside the contact pads.

Regarding claim 5, Yen teaches that the adjustment is achieved by forming an overmolded portion (Fig. 11, 114 & 113A) over the microcircuit (202).

Regarding claim 6, Yen teaches that the microcircuit (Fig. 11, 202) is fastened to the bottom shell (113).

Regarding claim 7, Tetaka et al teach the insulative adhesive (Fig. 46, 115) to fix a chip (111) and it would be obvious to apply this adhesive to fix the microcircuit to the bottom shell while insulating it.

Regarding claim 8, Yen teaches that the electronic component (Fig. 11, 202A) is disposed at a location (113A) offset from a location of the contact pads (111).

Regarding claim 9, Tetaka et al teach that the electronic component (Fig. 116, 311) is disposed on the same top face of the microcircuit as the contact pads (315) and it would be obvious to apply this structure to Yen to accommodate further electronic component to the circuit.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yen in view of Tetaka et al and further view of Lin et al (US 6,676,419).

Regarding claim 4, as best understood, Yen in view of Tetaka et al teach a process of making USB interface with a microcircuit; which reads on applicants' claimed invention, except for inserting the microcircuit into a shell having an access (213) on a rear edge.

Lin et al teach a process of fabricating a portable storing device with USB interface by inserting the microcircuit (Fig. 3, 24) into a shell (21 & 22) having an access on a rear edge in order to have a stabilized structure of forward and backward position of the contact terminal (Col. 1, lines 42-47).

It would be obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Yen in view of Tetaka et al by applying the design of forward or backward movement of contact terminal, as taught by Lin et al and not its general structure, in order to avoid the cost of the top switch (Fig. 8, 202C) and the unreliable contact cover (Fig. 14, 301) which tends to be lost and to permanently expose the contacts (Fig. 12, 111) and to have a

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stabilized structure of forward and backward position of the contact embedded in the circuit board (Fig. 12, 202).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Phan whose telephone number is 571-272-4568. The examiner can normally be reached on M & Tu, 6AM - 2PM, and W & Th, 9AM – 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Phan Thiem/
Primary Examiner, Art Unit 3729

December 22, 2008